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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

YOR919990064US2 (8728-258 CON)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on February 21, 2006

Signature

Typed or printed name Frank V. DeRosa

Application Number

10/776,909

Filed

February 11, 2004

First Named Inventor

Louis R. Degenaro

Art Unit

2189

Examiner

Woo H. Choi

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☐ attorney or agent of record.
Registration number _____

☒ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 43,584

Signature

Frank V. DeRosa

Typed or printed name

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Telephone number

February 21, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Degenaro, et al.

Examiner: Choi, Woo H.

Serial No.: 10/776,909

Group: Art Unit 2186

Filed: February 11, 2004

Docket: YOR919990064US2 (8728-258CON)

For: SYSTEM AND METHOD FOR MANAGING CACHABLE ENTITIES

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

Statement in Support of Pre-Appeal Brief Request for Review

This paper is being filed in support of Applicants' Pre-Appeal Brief Request for Review. A Notice of Appeal has been filed herewith in response to the Final Office Action mailed on November 18, 2005. Applicants respectfully contend that the claim rejections set forth in the Final Office Action are erroneous as a matter of law and/or fact for the following reasons.

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

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2/21/06

Frank V. DeRosa

Claim Rejections - 35 U.S.C. § 101

Claims 1-3, 5, 8-11, 14, 42 and 36 stand rejected as being directed to non-statutory subject matter for the reasons set forth on page 2 of the Final Office Action. Applicants respectfully assert that at the very least, the Final Office Action fails to provide a *prima facie* showing that claim 1 recites non-statutory subject matter directed to an abstract idea.

The Examiner's rejections are based essentially on a finding that "*the language of the claim raises a question as to whether the claims are directed merely to an abstract idea ...*" In order to establish a *prima facie* case of non-statutory subject matter based on an "abstract idea", the Examiner must identify the abstraction and explain why the claim covers every substantial application thereof. In the case at bar, the rejections are premised on Examiner's assertion that "*the claims seem to be directed to a method of planning/preparing with no practical application of the plan*", which "*amounts to a machined manipulated abstract idea.*" However, this analysis is legally deficient as a matter of law.

Indeed, in formulating the rejection of claim 1, the Examiner ignores the specifically claimed subject matter and, instead, identifies the "abstract idea" of the claim as being directed to a method of "planning/preparing". However, claim 1 does not specifically recite a method for "planning/preparing," but rather an automated method for managing a plurality of cachable entities. In this regard, the Examiner's analysis is backwards - the Examiner does not identify the abstraction with respect to the specific claimed subject matter (directed to a method for managing a plurality of cacheable entities), but instead appears to identify an "abstract idea" based on a generic characterization of the specifically claimed subject matter. This analysis is clearly not proper.

Moreover, even assuming, arguendo, that the “abstract idea” of claim 1 is properly identified as a “method for planning/preparing”, the Examiner offer no explanation as to how the subject matter of claim 1 (which is directed to a method for managing a plurality of cacheable entities) covers every substantial practical application of the identified abstraction of “planning/preparing”. In this regard, there is simply no reasonable basis to conclude that the claimed method of “managing cacheable entities” covers every substantial practical application of the abstract ideas of “planning/preparing”. Accordingly, the rejection should be withdrawn.

Claim Rejections - 35 U.S.C. § 112

Claims 42-44 and 46-48 stand rejected under 35 § U.S.C., first paragraph, as failing to comply with the written description requirement. Applicants respectfully submit that such rejections are clearly erroneous as a matter of law and fact.

Claims 42 and 46: Claims 1 and 18 recite “*determining a probability that the at least one statement will execute*” . Claims 42 and 46 (which depend from claims 1 and 18, respectively) recite “*determining said probability based on a likelihood of a value of a cacheable entity changing* “. In other words, claims 42 and 46 essentially recite that the probability that a statement will execute is determined based on a likelihood of a value of a cacheable entity changing, which Examiner contends is not described in Applicants’ specification and cites page 36, lines 14-23 of Applicants’ specification as being contradictory to the claimed subject matter.

However, the cited section provides clear support for claims 42 and 46. For example, page 36, lines 16-23 clearly describes an example in which the probability that a statement will execute (within a conditional branch) can be determined (through program analysis) based on a likelihood of the value of x changing.

Claims 43, 44, 47, 48: Claims 42 and 46 essentially recite that *said probability is determined based on a likelihood of a value of a cachable entity changing*. Since claims 43, 44, 47 and 48 depend from claim 42 or 46, the term “said probability” in claims 43, 44, 47 and 48 is *based on a likelihood of a value of a cachable entity changing*. In such case, the caching/updating/invalidating steps are performed depending of said probability (*likelihood of a value of a cachable entity changing* likelihood), which is explicitly described in Applicants’ specification.

Claim Rejections - 35 U.S.C. § 102

Applicants respectfully submit that at the very least, the Final Office Action does not set forth a *prima facie* case of anticipation of claims 1, 18 or 35 based on Nakanishi, Cytron, or Dubey, for those reasons set forth in Applicants’ Amendment filed on September 14, 2005, which is incorporated herein by reference.

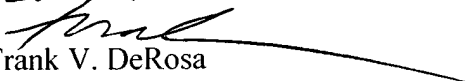
Claim Rejections - 35 U.S.C. § 103

Applicants respectfully submit that at the very least, the Final Office Action does not set forth a *prima facie* case of obviousness of claims 9 and 26 based on the combination of Cytron and Levine, for at least those reasons set forth in Applicants’ Amendment filed on September 14, 2005, which is incorporated herein by reference.

Double Patenting

Applicants may file a terminal disclaimer, if needed, in due course depending on the scope of allowed claims. At this time, Applicants request that the double patenting rejection be held in abeyance pending the disposition of this application.

Respectfully submitted,


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